Remarks

Claims 1-8 and 12-17 are pending in this application. By this Amendment, claims 1, 6 and 12-17 are amended. Support for these amendments can be found throughout the specification, including at least in the claims as originally filed and on page 28, lines 11-13.

No new matter is introduced by the foregoing amendments. After entry of this Amendment, **claims 1-8 and 12-17 continue to be pending in this application**. Consideration and allowance of the pending claims is requested.

This filing is proper after final rejection at least because it presents the claims in a better form for consideration, clarifies Applicants' position with regard to the pending rejections, and thereby places the case in better posture for an appeal if such is necessary.

Summary of Examiner Interview

Applicants thank Examiner McElwain for the courtesy of a telephone interview on February 4, 2009 with Applicants' representatives Drs. Anne Carlson and Michael Hammer. All pending rejections were discussed. Also discussed was the consideration of the remaining reference on the Information Disclosure Statement submitted to the United States Patent and Trademark Office on April 9, 2007. Agreement was reached regarding claim amendments necessary to overcome the rejections under 35 U.S.C. § 112, first paragraph for alleged lack of sufficient written description and enablement. While agreement was not reached regarding the rejections under 35 U.S.C. § 112, first paragraph (new matter) and second paragraph (indefiniteness), potential claim amendments and supporting arguments were discussed, which the Examiner agreed to consider. This amendment has been prepared in accordance with the telephone interview.

Information Disclosure Statement

Applicants remind Examiner McElwain that the Information Disclosure Statement submitted to the United States Patent and Trademark Office on April 9, 2007, which was considered by the Examiner in the Office action dated June 18, 2008, does not indicate that PCT Application No. WO 01/803697 (Exelixis Plant Sciences, Inc.) was considered. Thus, as requested in the Amendment

and Response submitted on October 20, 2008, Applicants respectfully request that the Office indicate that this reference was considered by signing and returning a copy in a subsequent communication. A copy of the appropriate page of the Form-1449 is provided herewith, for the Examiner's convenience.

Claim Objections

Claim 15 is objected to for the omission of the word "of" between "method" and "claim". By this Amendment, claim 15 has been amended to insert the word "of". Applicants request that this objection to claim 15 be withdrawn.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 1-8 and 12-17 are rejected under 35 U.S.C. § 112, second paragraph for allegedly being indefinite. The Office alleges that "it is unclear what the oil content would be compared to" (Office action at page 2) when the claims recite that a plant has a "high oil phenotype relative to a plant of the same species that does not comprise the plant transformation vector". Applicants respectfully traverse this rejection with regard to the claims as amended herein.

Independent claims 1 and 6 have been amended to recite a transgenic plant that has "a higher oil content relative to a plant of the same species that does not comprise the plant transformation vector". Example 5 of the specification (page 28, lines 1-17) clearly demonstrates that seeds from a plant transformed with a vector expressing the HIO103.1 polypeptide (*i.e.* a transgenic plant) have more oil ("a higher oil content") in comparison to seeds from a plant of the same species that is not transformed with such a vector (*i.e.* a non-transgenic plant). Therefore, it would be clear to one of skill in the art upon reading the specification what the oil content of the transgenic plant would be compared to. Thus, Applicants request that this rejection of claims 1-8 and 12-17 be withdrawn.

Rejections under 35 U.S.C. § 112, first paragraph (new matter)

Independent claims 1 and 6, and claims 2-5, 7, 8 and 12-17 dependent thereon, are rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. The Office alleges that the claims, as they were amended in response to the previous

Office action, contain new matter. Applicants respectfully traverse this rejection with regard to the claims as amended herein.

Independent claims 1 and 6 have been amended to recite a transgenic plant with "a higher oil content relative to a plant of the same species that does not comprise the plant transformation vector". This language closely parallels that of the specification at Example 5, which describes that seed from a plant that has been transformed with a plant transformation vector encoding the HIO103.1 polypeptide "have a higher oil content than seed from wild-type plants" (page 28, lines 12-13). Thus the specification contains the concept that the claimed transgenic plants have a higher oil content relative to plants that do not comprise the plant transformation vector. In addition to Example 5, this concept can be found in the definition of "altered oil content phenotype" which states that a plant with such a phenotype "displays a statistically significant increase or decrease in overall oil content . . . as compared to the similar, but non-modified plant" (page 5, lines 30-34). Thus, both the language and the concept of the claims as amended can be found within the specification. Applicants request that this rejection of claims 1-8 and 12-17 be withdrawn.

Rejections under 35 U.S.C. § 112, first paragraph (written description)

Claims 1-8 and 12-17 are rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. The Office alleges that the specification does not provide "sequences that produce a high oil or altered oil phenotype . . . [that are] complementary [to SEQ ID NO:2]" (Office action at page 4). Applicants traverse this rejection. However, solely to advance prosecution in this case, claims 1, 6 and 12-17 have been amended to delete the phrase "or is complementary to a sequence that encodes". Applicants believe that this amendment accurately reflects the agreement reached with the Examiner regarding the amendments necessary to overcome the rejection under 35 U.S.C. § 112, first paragraph for lack of adequate written description. Thus, Applicants request that this rejection to claims 1-8 and 12-17 be withdrawn.

Rejections under 35 U.S.C. § 112, first paragraph (enablement)

Claims 1-8 and 12-17 are rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the enablement requirement. The Office alleges that the specification "does not

reasonably provide enablement for a transgenic plant comprising a plant transformation vector comprising . . . any sequence complementary [to SEQ ID NO:2], and wherein the transgenic plant has a high oil or altered oil phenotype" (Office action at page 5). Applicants traverse this rejection. However, solely to advance prosecution in this case, and as noted above, claims 1, 6 and 12-17 have been amended to delete the phrase "or is complementary to a sequence that encodes". Applicants believe that this amendment accurately reflects the agreement reached with the Examiner regarding the amendments necessary to overcome the rejection under 35 U.S.C. § 112, first paragraph for lack of enablement. Thus, Applicants request that this rejection of claims 1-8 and 12-17 be withdrawn.

Conclusion

Based on the foregoing amendments and arguments, the pending claims are in condition for allowance, and notification to that effect is requested. If for any reason the Examiner believes that a telephone conference would expedite allowance of the claims, please telephone the undersigned at the telephone number listed below.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300
Facsimile: (503) 595-5301

By /Michael D. Hammer/
Michael D. Hammer, Ph.D.
Registration No. 59,258